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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,069	12/06/2001	Masashi Shiomi	0033-0778P	4862
2292 7590 09/13/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PAULA, CESAR B	
			ART UNIT 2178	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/003,069

Applicant(s)

SHIOMI ET AL.

Examiner

CESAR B. PAULA

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the response filed on 4/11/2007.

This action is made Final.

2. In the amendment, claims 40-55 are pending in the case. Claims 40, 47, and 52-55 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 2000-371676 filed in Japan on 12/6/2000, which papers have been placed of record in the file.

Drawings

4. The drawings filed on 12/6/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 52, and 54 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. Claim 52 recites “*in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application*” lines 10-12. The Examiner has failed to find in the specification explanation enabling one of ordinary skill in the art to perform the display of the ad before running the application with the additional data. It appears that the additional data is used before the display of the ad (spec. pages 30, and 32). The Applicant remarks that the specification discloses that a user presses button 603, in response, the control unit reads additional data and executes the application using the additional data (page 2, last 3 lines). While it is true that the specification shows the display of an ad before running the application, this is **not** done in response to the user’s request to run the application using the additional data as recited in the claim. The ad is displayed before the user requests the application to run.

8. Claim 54 recites “while the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data” lines 9-10. The Examiner has failed to find in the specification explanation enabling one of ordinary skill in the art to perform this limitation. The Applicant remarks that the specification teaches that it

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“provides support for claim 54. Page 29, line 33 begins a discussion of a user terminating an application, removing a storage medium from the game, and downloading additional data to the storage medium. Details of this procedure continue on page 30 and 31” (page 2, last 3 lines).

The specification shows the terminating of the application, and the downloading of data.

However, the receiving and saving of additional data does **not take place while the application is terminated, but rather after the application is terminated.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 52 remains rejected under 35 U.S.C. 102(e) as being anticipated by Shaw (Pat.# 6,199,106, 3/6/2001, filed on 9/14/1998).

Regarding independent claim 52, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *storing an application, data to be acted upon by the application and advertising data in computer readable form;* (col.5, lines 24-47)

Moreover, Shaw teaches displaying advertisement ,while online, and transmitting information between the client program, and a server. The advertisement is displayed using files that contain the ads, along with notations in PDL—*additional data to be acted on* for displaying the ads-- for describing the data that forms part of the ads (col.5, lines 28-31, col.14, lines1-67)-- *displaying an advertisement based on the advertising data; running the application using the data to be acted upon by the application; receiving and saving additional data to be operated upon by the application and additional advertising data;*

Furthermore, Shaw teaches displaying advertisement using the client program while offline. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-67, col.7, lines 1-3, col.14, lines1-67). In other words the client program—*application--* receives a request from a scheduler to display a specific ad before the display of the ad. The client program, then displays and runs to accomplish the display of the ad --*receiving a request to run the application using the additional data to be operated upon by the application; in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application.*

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 40-47, and 49-51, and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, in view of Granik et al, hereinafter Granik (USPub 2002/0010757 A1, 1/24/2002, filed on 12/1/2000).

Regarding independent claim 40, Shaw teaches a client program transmitting email, and disconnecting. Before the client program disconnects, the program downloads advertisements (col.4, lines 11-20, col.5, lines 18-47, col.3, lines 12-16)—*receiving and saving additional data to be operated upon by the application and additional advertising data;*

Moreover, Shaw teaches displaying advertisement using the client program while offline. The advertisement contains notations in PDL—*additional data to be acted on* for displaying the ads-- for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines 1-67)—*displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application;* Shaw fails to explicitly teach *after the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data.* However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. The application works at a predetermined regularly recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik to automatically download ads at a predetermined time

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using an update application, which is separate from the email application, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012). This would permit the user to view the latest ads without the hassle, and effort of having the email browser constantly on.

Regarding claim 41, which depends on claim 40, Shaw teaches displaying advertisement while offline using the client program using notations in PDL for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines 1-67)—*displaying an advertisement based on the additional advertising data in response....*;

Regarding claim 42, which depends on claim 41, Shaw teaches displaying advertisement while offline, and displaying additional information once the ad is clicked on (col.13, lines 47-67)—*requiring an input from a user....*

Regarding claim 43, which depends on claim 40, Shaw teaches displaying advertisement, which is downloaded using data collected from previous client session. (col.7, lines 3-67);

Regarding claim 44, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

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Regarding claim 45, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

Regarding claim 46, which depends on claim 40, Shaw teaches displaying advertisement while offline, and receiving displaying additional information once the ad is clicked on (col.13, lines 47-67)--

Regarding independent claim 47, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *a processor for running the application using the data to be acted upon by said application and for displaying an advertisement based on said advertising data* (col.5, lines 24-47)

Furthermore, Shaw teaches displaying advertisement while offline using the client program--*application--*. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-46, col.14, lines 1-67)-- *an input for inputting an instruction to run said application using said additional data to be acted upon by said application*. Shaw fails to explicitly teach *information receiving unit for receiving, when said processor is not running the application, additional data to be acted upon by said application and additional advertising data*. However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. The application works at a predetermined regularly

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recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012).

Regarding claim 49, which depends on claim 47, Shaw teaches displaying advertisement, which is downloaded using data collected from previous client session. (col.7, lines 3-67)—
execution result of said application;

Regarding claim 50, which depends on claim 49, Shaw teaches a server for specifying advertisement to be downloaded. (col.7, lines 17-67);

Regarding claim 51, which depends on claim 47, Shaw teaches a server for specifying advertisement to be downloaded, which include pdf information for displaying the advertisement. (col.7, lines 17-67, col.14, lines 1-67);

Regarding independent claim 53, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *an information storing medium storing an application, data to be acted upon by said application, and advertising data, a processor for running the application using the data to be acted upon by said application and for displaying an advertisement based on said advertising data* (col.5, lines 24-47)

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Furthermore, Shaw teaches displaying advertisement while offline using the client program. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads *an input for inputting an instruction to run said application using additional data to be acted upon by said application* (col.4, lines 41-46, col.14, lines 1-67). Shaw fails to explicitly teach *wherein said data to be acted upon by the application does not comprise advertising information or formatting information for advertising information; an information receiving unit for receiving, when said processor is not running the application, additional data to be acted upon by said application and additional advertising data*; However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. — *data not comprising advertising information*. The application works at a predetermined regularly recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012).

Regarding independent claim 54, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *storing an application, data to be acted upon by the application and advertising data in computer readable form* (col.5, lines 24-47)

Moreover, Shaw teaches displaying advertisement while online transmitting information between the client program, and a server and disconnecting. Before the client program

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disconnects, the program downloads advertisements. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 11-20, col.5, lines 18-47, col.14, lines1-67)-- *displaying an advertisement based on the advertising data; running the application using data to be acted upon by the application; while the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data;*

Furthermore, Shaw teaches displaying advertisement while offline using the client program. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-67, col.7, lines 1-3, col.14, lines1-67). In other words the client program receives a request from a scheduler to display a specific ad before the display of the ad. The client program, then displays and runs the application to accomplish the display of the ad -- *displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application.* Shaw fails to explicitly teach *wherein said data to be acted upon by the application does not comprise advertising information or formatting information for advertising information;* However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. — *data not comprising advertising information.* The application works at a predetermined regularly recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012).

Regarding independent claim 55, Shaw teaches the storage of advertisement, and PDL information to be used in the display of information by a computer-- *storing an application, data to be acted upon by the application and advertising data in computer readable form* (col.5, lines 24-47).

Moreover, Shaw teaches displaying advertisement while online transmitting information between the client program, and a server. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.5, lines 28-31, col.14, lines1-67)-- *displaying an advertisement based on the advertising data; running the application using the data to be acted upon by the application; receiving and saving additional data to be operated upon by the application and additional advertising data;*

Furthermore, Shaw teaches displaying advertisement while offline using the client program. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-67, col.7, lines 1-3, col.14, lines1-67). In other words the client program receives a request from a scheduler to display a specific ad before the display of the ad. The client program, then displays and runs the application to accomplish the display of the ad --*receiving a request to run the application using the additional data to be operated upon by the application; in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application.* Shaw fails to explicitly teach wherein said

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data to be acted upon by the application does not comprise advertising information or formatting information for advertising information; However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. — *data not comprising advertising information.* The application works at a predetermined regularly recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012).

12. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, in view of Granik, and further in view of Acres (USPub 2001/0034643 A1, 10/25/2001, provisional filed on 3/10/2000).

Regarding claim 48, which depends on claim 47, Shaw teaches displaying advertisement while offline using the client program using notations in PDL for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines1-67); Shaw fails to explicitly disclose: *said application comprises a game.* Acres discloses displaying ads on a game application (0016). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Shaw, Granik, and Acres, because Acres teaches the display of ads while offline. This would provide the benefit of reducing the costs of being constantly connected to the network, while freeing up resources that could be used by the computer elsewhere, such as playing the game.

Response to Arguments

13. Applicant's arguments filed 6/25/2007 have been fully considered but they are not persuasive.

Regarding claim 52, the Applicant indicates that the Examiner failed to address the previous argument, and therefore a new non-final rejection or a withdrawal of the 35 USC 102 rejection should be issued (pages 3-4). The Examiner disagrees because it was shown that Shaw teaches displaying advertisement using the client program while offline. The advertisement is displayed using files that contain the ads, along with notations in PDL for describing the data that forms part of the ads (col.4, lines 41-67, col.7, lines 1-3, col.14, lines1-67). In other words, the client program receives a request from a scheduler to display a specific ad before the display of the ad. The client program, then displays and runs the application to accomplish the display of the ad --*receiving a request to run the application using the additional data to be operated upon by the application; in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application.* As indicated above, the Examiner has interpreted Shaw to teach claimed invention in that an ad is displayed using PDL notations, in response to a request to display the ad using the PDL notations—*additional data to be operated upon by the application--*, where the request takes place before the email application is run to display the ad.

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Regarding claims 40-47, 49-51, and 53-55, the Applicant argues that the modification to Shaw has not been identified, and that a proper reason has not been given for modifying Shaw (page 4, parag. 3-page 6). The Examiner disagrees, because as it has been previously shown (office action, 4/11/07, page 6), Shaw teaches displaying advertisement using the client program—*application--* while offline. The advertisement contains notations in PDL—*additional data to be acted on* for displaying the ads-- for describing the data that forms part of the advertisement (col.4, lines 41-46, col.14, lines1-67)—*displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted upon by the application*; Shaw fails to explicitly teach *after the application is terminated, receiving and saving additional data to be operated upon by the application and additional advertising data*. However Granik discloses using a separate update application for downloading ad data based on personal profile data, such as ad/image, application updates, configuration files, etc. The application works at a predetermined regularly recurring time or event by automatically connecting to a server(s) (0026, 0034-0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shaw, and Granik to automatically download ads at a predetermined time using an update application, which is separate from the email application, because of all the reasons found in Granik, including the enhancement, and personalization of web browsing experience (0012). This would permit the user to view the latest ads without the hassle of having the email viewer on to perform the downloading.

Regarding claim 47, the Applicant remarks that nothing in Shaw or Granik shows additional information is ever provided (page 6, last parag.). The Examiner disagrees, because

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Granik teaches profile data being received for carrying out automatic update at a regularly scheduled time-- while a browser is offline (0026).

Regarding claims 53-55, the Applicant remarks that the rejection continues to refer to the additional data to be acted on as being taught by Shaw, although Shaw fails to teach that this additional data is not advertising data (page 7). This is not a contradiction, because Shaw does teach additional data. However, Shaw does not teach that the additional data does not comprise advertising data. Granik makes up the difference in the shortcomings of Shaw by teaching profile data, such as configuration files— data not comprising advertising information.

Claim 48 remains rejected at least based on the rationale put forth above.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
9/5/2007